

Appl. No. 10/017,513  
Response dated July 11, 2005  
Reply to Office action of June 14, 2005

**Unavailability of Hamamatsu under 35 U.S.C. § 102(e)**

The examiner has rejected claims 1-10 under 35 U.S.C. § 102(e) in respect to Hamamatsu.

Per MPEP 706.02 35 U.S.C. § 102(e) provides a person shall be entitled to a patent unless:

(e) the invention was described in - (1) an application for patent, published under **section 122(b)**, by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in **section 351(a)** shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under **Article 21(2)** of such treaty in the English language; or

Under 35 U.S.C. § 102(e) (1) it is noted that Hamamatsu was not filed in the U.S. until 10/23/2002, after the 12/14/2001 filing date of the present application. Under 35 U.S.C. § 102(e)(2) it could be considered prior art if it were an international application filed under treaty defined in section 351(a) (a PCT application) and would thereby receive benefit of the priority filing date of 10/24/2001 Japan filing date if it was published under Article 21(2) of the treaty in English. Note that MPEP 901.03 (MPEP page 900-3) explains "...a U.S. patent application publication of a National Stage application is considered to be prior art under 35 U.S.C. 102(e) as of the international filing date only if the International Application designated the United States and was published by the International Bureau (IB) in English" (emphasis added). Applicant does not find any reference on the Hamamatsu patent or the earlier US 2003/0086580 A1 May 8, 2003 published application that the patent originated as a PCT application or was ever published as a PCT publication. Accordingly applicant believes that Hamamatsu U.S. Patent 6,795,560 is not a proper reference under 35 U.S.C. § 102(e). Pertinent pages from the MPEP and front pages of the Hamamatsu patent and publication are submitted herewith for convenience.

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### **Unavailability under 35 U.S.C. § 103**

The examiner has rejected claims 11-12 under 35 U.S.C. § 103(a) in respect to Hamamatsu. Applicants note that 35 U.S.C. 103(a) pertains to patents "... not identically disclosed or described as set forth in section 102 ..." and thus is inapplicable as set forth in respect to 35 U.S.C. § 102.

### **Prior Invention by Applicants**

Applicants note that the priority date of Hamamatsu is the 10/24/01 date of the JP 2001-325969 application. Applicant calls attention to the 10/15/01 date on the present application's originally filed Figures 1-3 which along with the written specification describe the claimed invention in detail. In that Applicant's have by virtue of their declaration, declared "I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, ..." and "... that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true ..." it is believed that the evidence of prior invention already contained in the application and supported by the applicants' declarations is adequate to demonstrate conception, diligence and reduction to practice predating Hamamatsu's Japan filing date. A copy of original Figures 1-3 is submitted herewith for convenience.

Applicants submit herewith is a declaration by J. Carl Cooper, President of Pixel Instruments Corp., the owner of the application, demonstrating conception prior to Hamamatsu's Japan priority date along with diligence until the reduction to practice via early schematics of the preferred embodiment of the invention received thereby on March 7, 2001 and later schematics received the week of October 15, 2001. Note the similarity between these schematics and Figures of the application as filed. In the event the Commissioner finds this evidence unpersuasive, applicants reserve the right to submit further evidence and declarations supporting prior invention.

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### Premature Final Rejection

As provided in MPEP 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in **37 CFR 1.97(c)** with the fee set forth in **37 CFR 1.17(p)**.

It is believed that the examiner introduced a new ground of rejection, and new reference by Hamamatsu, which was neither necessitated by applicant's amendment nor based on information submitted in an IDS. Note that as pointed out at page 10 of Applicants' Amendment of 02/02/05

"[w]hile the claims as previously worded are believed allowable over Asakura, applicant has amended the independent claims 1, 4, 7 and 8 to more clearly point out the distinctions thereby avoiding possible frivolous misinterpretations of the claims by an unscrupulous copyist, rather than for reasons of allowance."

As set forth in MPEP 706.07:

Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

Here the examiner has switched from one reference to another in rejecting substantially the same subject matter. Applicants submit that the final rejection is premature in view of this new ground of rejection and new prior art.

In view of the inapplicability of the only remaining prior art as discussed above it is respectfully requested that the pending claims be allowed and the application be passed to issue. Alternatively, in the event that all claims are not allowed it is requested that the holding of final rejection be withdrawn in order to allow "... reaching a clearly defined issue ..." and as set forth in

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MPEP 706.07 with respect to the proper interpretation of Hamamatsu and/or proper interpretation of the claims and/or establishment of date of invention prior to Hamamatsu.

In that the application is believed in form for allowance, further action in that respect is respectfully solicited. In the event

Respectfully Submitted,



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I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306 on July 11, 2005.



J. Carl Cooper

## PATENT LAWS

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(4) any proposed disposition of surplus fees by the Office; and

(5) such other information as the committees consider necessary.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 4, 89 Stat. 690; Dec. 12, 1980, Public Law 96-517, sec. 3, 94 Stat. 3018; Aug. 27, 1982, Public Law 97-247, sec. 3(g), 96 Stat. 319; Sept. 13, 1982, Public Law 97-258, sec. 3(i), 96 Stat. 1065.)

(Subsection (c) amended Dec. 10, 1991, Public Law 102-204, sec. 5(e), 105 Stat. 1640.)

(Subsection (e) added Dec. 10, 1991, Public Law 102-204, sec. 4, 105 Stat. 1637.)

(Subsection (c) revised Nov. 10, 1998, Public Law 105-358, sec. 4, 112 Stat. 3274.)

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-555, 582 (S. 1948 secs. 4205 and 4732(a)(10)(A)).)

## PART II — PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

### CHAPTER 10 — PATENTABILITY OF INVENTIONS

Sec.

100 Definitions.

101 Inventions patentable.

102 Conditions for patentability; novelty and loss of right to patent.

103 Conditions for patentability; non-obvious subject matter.

104 Invention made abroad.

105 Inventions in outer space.

#### 35 U.S.C. 100 Definitions.

When used in this title unless the context otherwise indicates -

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

(e) The term "third-party requester" means a person requesting ex parte reexamination under section 302 or inter partes reexamination under section 311 who is not the patent owner.

(Subsection (e) added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-567 (S. 1948 sec. 4603).)

#### 35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

#### 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless —

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the inter-

national application designated the United States and was published under Article 21(2) of such treaty in the English language; or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

(Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; Nov. 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691.)

(Subsection (e) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-565 (S. 1948 sec. 4505).)

(Subsection (g) amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-590 (S. 1948 sec. 4806).)

(Subsection (e) amended Nov. 2, 2002, Public Law 107-273, sec. 13205, 116 Stat. 1903.)

### 35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b)(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is

novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.

(3) For purposes of paragraph (1), the term "biotechnological process" means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(Amended Nov. 8, 1984, Public Law 98-622, sec. 103, 98 Stat. 3384; Nov. 1, 1995, Public Law 104-41, sec. 1, 109 Stat. 3511.)

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**35 U.S.C. 316 Certificate of patentability, unpatentability and claim cancellation**

(a) **IN GENERAL.**— In an inter partes reexamination proceeding under this chapter, when the time for appeal has expired or any appeal proceeding has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent any proposed amended or new claim determined to be patentable.

(b) **AMENDED OR NEW CLAIM.**— Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes reexamination proceeding shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, prior to issuance of a certificate under the provisions of subsection (a) of this section.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

**35 U.S.C. 317 Inter partes reexamination prohibited**

(a) **ORDER FOR REEXAMINATION.**— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.

(b) **FINAL DECISION.**— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or

could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)); subsections (a) and (b) amended Nov. 2, 2002, Public Law 107-273, sec. 13202, 116 Stat. 1901.)

**35 U.S.C. 318 Stay of litigation**

Once an order for inter partes reexamination of a patent has been issued under section 313, the patent owner may obtain a stay of any pending litigation which involves an issue of patentability of any claims of the patent which are the subject of the inter partes reexamination order, unless the court before which such litigation is pending determines that a stay would not serve the interests of justice.

(Added Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-570 (S. 1948 sec. 4604(a)).)

**PART IV — PATENT COOPERATION TREATY****CHAPTER 35 — DEFINITIONS**

Sec.

351 Definitions.

**35 U.S.C. 351 Definitions.**

When used in this part unless the context otherwise indicates—

(a) The term “treaty” means the Patent Cooperation Treaty done at Washington, on June 19, 1970.

(b) The term “Regulations,” when capitalized, means the Regulations under the treaty, done at Washington on the same date as the treaty. The term “regulations,” when not capitalized, means the regulations established by the Director under this title.

(c) The term “international application” means an application filed under the treaty.

(d) The term “international application originating in the United States” means an international appli-

## PRIOR ART, CLASSIFICATION, SEARCH

901.04

37 CFR 1.215 and 1.219. In addition, applications filed prior to November 29, 2000, but pending on November 29, 2000, may be published if a request for voluntary publication is filed. See 37 CFR 1.221. Patent applications filed on or after November 29, 2000, and those including a request for voluntary publication shall be published except for the following enumerated exceptions.

First, an application shall not be published if it is:

- (A) no longer pending;
- (B) subject to a secrecy order under 35 U.S.C. 181 or an application for which publication or disclosure would be detrimental to national security;
- (C) a provisional application filed under 35 U.S.C. 111(b);
- (D) an application for a design patent filed under 35 U.S.C. 171; or
- (E) a reissue application filed under 35 U.S.C. 251.

Second, an application shall not be published if an applicant submits at the time of filing of the application a request for nonpublication, certifying that the invention disclosed in the U.S. application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires eighteen month publication. See 37 CFR 1.213(a). An applicant may rescind such a request at any time. See 37 CFR 1.213(b). If the applicant who has submitted a nonpublication request subsequently files an application directed to the invention disclosed in the U.S. application, in which the nonpublication request was submitted, in another country, or under a multilateral international agreement, that requires publication of the application eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. See 37 CFR 1.213(c). In addition, if an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign-filed applications or the description of the invention in such foreign-filed applications is less extensive than the application or description of the invention in the application filed in the USPTO, the applicant may submit a redacted copy of the application filed in the Office eliminating any part or description of the invention in the U.S.

application that is not also contained in any of the corresponding applications filed in a foreign country. If the redacted copy of the U.S. application is timely received in the Office, the Office may publish only the redacted copy. See 35 U.S.C. 122(b)(2)(B)(v) and 37 CFR 1.217.

U.S. patent application publications are prior art under 35 U.S.C. 102(a) and 102(b) as of the publication date. Under amended 35 U.S.C. 102(e)(1), a U.S. patent application publication is considered to be prior art as of the earliest effective U.S. filing date of the published application. Additionally, a U.S. patent application publication of a National Stage application is considered to be prior art under 35 U.S.C. 102(e) as of the international filing date only if the International Application designated the United States and was published by the International Bureau (IB) in English.

Any new prior art created by the changes to 35 U.S.C. 102(e) may only be applied against applications that are filed on or after November 29, 2000, and against applications filed prior to November 29, 2000 that are pending on November 29, 2000 and are voluntarily published. The new prior art effects created by amended 35 U.S.C. 102(e) will not be applicable to any application filed before November 29, 2000 and not voluntarily published, nor a reexamination of a patent issued on such an application. Additionally, the new prior art effect created by amended 35 U.S.C. 102(e) will not be applicable to any National Stage application, complying with 35 U.S.C. 371(c), whose international filing date is before November 29, 2000 if it is not voluntarily published.

## 901.04 U.S. Patents

The following different series of U.S. patents are being or in the past have been issued. The date of patenting given on the face of each copy is the publication date and is the one usually cited. The filing date, in most instances also given on the face of the patent, is ordinarily the effective date as a reference (35 U.S.C. 102(e)). See MPEP § 2127, paragraph II. The 35 U.S.C. 102(e) date for a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application.